

defeat attaining the goal of reaching a clearly defined issue for an early termination, i.e., either an allowance of the application or a final rejection. ... The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application. ... The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal. (emphasis added)

In the first Office Action, mailed August 22, 2007, the Examiner rejected claims 1-5 under 35 U.S.C. § 102(b) over Nakano et al. (United States Patent No. 6,306,957), rejected claim 6 under 35 U.S.C. § 103(a) over Nakano et al. in view of Fukui et al. (United States Patent Application Publication No. 2004/0254275), and further rejected claim 7 under 35 U.S.C. § 101. In response to the rejections, the Applicant amended independent claim 1 to correct an inadvertent grammatical error with regard to the formula for (A₁) by replacing the subscript “a” at the end of the formula with the subscript “d”. The Applicant also amended independent claim 1 to delete (A₂) from being an available option for the claimed silicone oil (A), and likewise deleted the claimed variables “R⁴” and “p” because those variables were only present in the formula for (A₂). As such, the effect of the amendment to claim 1 was merely to overcome the rejection of claims 1-5 under 35 U.S.C. § 102(b) over Nakano et al., **and the amendment did not introduce new subject matter that was not previously claimed**. Rather, claim 1 as amended included the previously-claimed subject matter of claim 6. Notably, claim 6 claimed (A₁) and (A₃) as options for (A) but clearly included (A₂) as an option. While claim 6 does include other elements, claim 1 was **not** amended in a way that presented subject matter that was **not already searched**, and therefore **the amendments to claim 1 did not necessitate a new search**. In effect, the Examiner provided a new rejection of subject matter that was previously claimed in a dependent claim, i.e., claim 6, without providing the Applicant with an opportunity to respond.

In first applying this reference and the attendant rejection in a Final Office Action, the Examiner has prevented the Applicant from making numerous substantive arguments. Said another way, the Examiner, by first applying Peterson in a Final Office Action, has **prematurely cut off** the prosecution of the application. In accordance with the above,

the finality of the second Office Action is premature, improper, and should be withdrawn.

Although no fees are believed due, the Commissioner is hereby authorized to charge any fees or credits to Deposit Account No. 08-2789.

Respectfully submitted,

HOWARD & HOWARD ATTORNEYS, P.C.

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Date

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